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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,181	01/16/2002	William C. Stallings	3333/1/US	4778

7590 09/11/2003

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EXAMINER

SAEED, KAMAL A

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/031,181	STALLINGS ET AL.	
	Examiner	Art Unit	
	Kamal A Saeed	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-12,14-17,19-24,26-34,37-44,46-54 and 57-63 is/are pending in the application.
- 4a) Of the above claim(s) 19-24,26-34,37-44,46-54 and 57-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,11,12,14,16 and 17 is/are rejected.
- 7) ☒ Claim(s) 7,8,10 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 9,13, 18, 25, 35, 36, 45, 55, 56 and 64 have been cancelled and claims 1-8,10-12, 14-17, 19, 21, 26, 32-34, 37-39, 41, 46, 52-54, 57-59 and 61-63 16-19, 32, 34-37, 39, 41, 46, 52-54, 57-59 and 61-63 have been amended by preliminary amendment filed on June 06, 2003. Therefore claims 1-8,10-12, 14-17, 19-24, 26-34, 37-44, 46-54 and 57-63 are currently pending in this application.

Claims 19-24, 26-34,37-44, 46-54 and 57-63 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

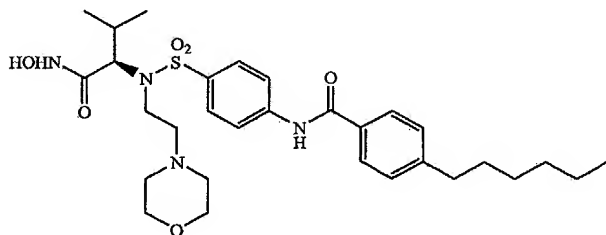
Applicant's Information Disclosure Statements, filed on June 11, 2002 has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Priority

This application is a national-phase application of PCT Patent Application No. PCT/US00/16323, which claims the benefit of US Provisional Application 60/144,133 filed on July 16, 1999.

Response to Restriction

Applicant's election of Group II, claims 1-8,10-12,14-17 (as currently amended), drawn to compounds of structural formula as depicted in claim 1, and the specific compound,



, depicted in claim 17 is acknowledged.

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The examiner is grateful for Applicants cooperation in the Amendment filed, June 06, 2003 to limit claims 1-8,10-12 and 14-17 to elected subject matter. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). As far as the method of use claims are concerned, In accordance with M.P.E.P. 821.04 and In re Ochiai, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims and method of use claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims and process is deemed proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Status of the Claims

Claims 1-8,10-12, 14-17, 19-24, 26-34, 37-44, 46-54 and 57-63 are pending in this application. The scope of the invention of the elected invention encompassing the elected subject matter is follows:

The compound of formula I, of claim 1, wherein:

R^2 is morpholinoalkyl; R^{20} is selected from the group consisting of $-C(O)NHOH$, $-SH$, $C(O)OH$, and $-C(O)SH$; R^3 , R^{21} , R^{22} , R^{23} , R^{24} and R^{25} are as defined in claim 1. As previously stated claims 1-8,10-12,14-17 read on the elected subject matter.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 11, 12, 14, 16 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-24 and 29-32 of U.S. Patent No. 6,451,791. Instant claims 1-6, 11, 12, 14, 16 and 17 disclose an amidoaromatic ring sulfonamide hydroxamic acid compound, an enantiomer, diastereomer, racemate, or tautomer of the compound or a salt of the compound of the formula depicted in claim 1, wherein: **R**² represents morpholinoalkyl; **R**³ represents alkyl group; **R**²⁰ represents -C(O)NHOH; **R**²¹, **R**²², **R**²⁴ and **R**²⁵ each independently represent hydrogen; and **R**²³ is C₁-C₂₀ linear alkyl. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because US Patent No. 6,451,791 which discloses specific compounds and salts (see claims 21-24 and 29-32) which are more specific embodiments that anticipate the compounds and salts as instantly claimed and one skilled in the art would have been motivated to make enantiomers, diastereomers or tautomers of the claimed compounds and salts when faced with the prior US Patent No. 6,451,791.

Claim Objections

Claims 7, 8, 10 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and " Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed
Kamal Saeed, Ph.D.,
Patent Examiner, Art 1626